

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.,
Petitioner,

v.

AT&T INTELLECTUAL PROPERTY I, L.P.,
Patent Owner.

Case IPR2015-01227
Patent 7,907,714 B2

Before MICHAEL R. ZECHER, BRIAN P. MURPHY, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Cox Communications, Incorporated (“Cox”), filed a revised, amended Petition requesting an *inter partes* review of claims 1–22 of U.S. Patent No. 7,907,714 B2 (“the ’714 patent,” Ex. 1001). Paper 9 (“Pet.”). Patent Owner, AT&T Intellectual Property I, Limited Partnership (“AT&T”), timely filed a Preliminary Response. Paper 12 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Taking into account the arguments presented in AT&T’s Preliminary Response, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Cox will prevail in challenging claims 1–22 of the ’714 patent as unpatentable under 35 U.S.C. §§ 102(e) and 103(a). Pursuant to § 314, we hereby authorize an *inter partes* review to be instituted as to these claims of the ’714 patent.

A. *Related Matters*

The ’714 patent has been asserted in a district court case titled *AT&T Intellectual Prop. I, L.P. v. Cox Commc’n, Inc.*, No. 14-1106-GMS (D. Del.). Pet. 1; Paper 4, 2. In addition to this Petition, Cox filed other petitions challenging the patentability of a certain subset of claims in the following patents owned by AT&T or one of its affiliates: (1) U.S. Patent No. 6,993,353 B2 (Case IPR2015-01187); (2) U.S. Patent No. 6,487,200 B1 (Case IPR2015-01273); and (3) U.S. Patent No. 8,855,147 B2 (Case IPR2015-01536).

A. The '714 Patent

The '714 patent, titled “Profile Management System Including User Interface for Accessing and Maintaining Profile Data of User Subscribed Telephony Services,” issued March 15, 2011, from U.S. Patent Application No. 11/459,121, filed on July 21, 2006. Ex. 1001, at [54], [45], [21], [22]. The '714 patent claims priority to the following applications: (1) U.S. Patent Application No. 10/761,382, filed on January 22, 2004—now U.S. Patent No. 7,103,165; (2) U.S. Patent Application No. 09/050,986, filed on March 31, 1998; and (3) U.S. Provisional Application No. 60/042,680, filed on April 3, 1997. *Id.* at [63], [60].

The '714 patent generally relates to the field of telecommunications and, in particular, to a user interface, e.g., on a personal computer (“PC”), that allows a user to access and maintain profile data associated with the user’s subscribed telephone service. Ex. 1001, 1:31–35. According to the '714 patent, prior art systems limit a user’s ability to access and maintain its service profile data freely. *Id.* at 3:49–51. For instance, dual tone multi-frequency-based interfaces do not provide an efficient or user-friendly system that allows a user to review and revise its service profile data. *Id.* at 3:54–56. In addition, advanced intelligent network (“AIN”)-based services do not provide an effective solution for automated service management and maintenance. *Id.* at 3:56–61. Consequently, the '714 patent asserts that a need exists for a user interface that allows a user to perform the following functions: (1) access and maintain its service profile data freely; and (2) review and update its service data without requiring the involvement of, or interaction with, service personnel. *Id.* at 3:61–67.

The '714 patent purportedly addresses this need by providing a profile management system that includes a user interface, such as a PC interface, for accessing and maintaining profile data of a user's subscribed telephone service. Ex. 1001, 6:62–65. The telephony service, which may be an AIN-based service, includes profile data that controls or defines the service features and parameters associated with the service subscribed to by the user. *Id.* at 6:65–7:2. The user employs the user interface to access, maintain, and modify its service profile data freely, and without the involvement of, or interaction with, service personnel. *Id.* at 7:2–5; *see also id.* at 5:20–23, 6:8–11, 6:18–21 (disclosing the same).

B. Illustrative Claim

Of the challenged claims, claims 1 and 13 are independent. Independent claim 1 is directed to a method for managing, by a profile management system, subscriber profile data associated with a communications service subscribed to by a subscriber. Independent claim 13 is directed to a similar method. Claims 2–12 directly or indirectly depend from independent claim 1; and claims 14–22 directly or indirectly depend from independent claim 13. Independent claim 1 is illustrative of the challenged claims and is reproduced below:

1. A method for managing, by a profile management system, subscriber profile data associated with a communications service subscribed to by a subscriber, the subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data, the method comprising:
 - receiving a subscriber request to view the subscriber profile data from a client which hosts a user interface

configured to allow the subscriber to view and update the subscriber profile data;

retrieving the subscriber profile data from the communications network based upon receiving the subscriber request to view the subscriber profile data from the client;

forwarding the subscriber profile data to the client;

receiving a subscriber request to update the subscriber profile data from the client, and

forwarding an update for the subscriber profile data to the communications network based upon receiving the subscriber request to update the subscriber profile data from the client.

Ex. 1001, 15:58–16:11

C. Prior Art Relied Upon

Cox relies upon the following prior art references:

Blumhardt	US 5,629,978	May 13, 1997 (filed Nov. 16, 1995)	Ex. 1003
Buhrmann	US 5,903,845	May 11, 1999 (filed June 4, 1996)	Ex. 1004
An	US 6,031,904	Feb. 29, 2000 (effectively filed Oct. 23, 1996)	Ex. 1005
Elliott	US 6,335,927 B1	Jan. 1, 2002 (filed Nov. 18, 1996)	Ex. 1007
Boulware	US 5,757,899	May 26, 1998 (effectively filed July 21, 1995)	Ex. 1008
Bayless	US 5,754,636	May 19, 1998 (effectively filed Nov. 1, 1994)	Ex. 1009
Beck	US 5,883,946	Mar. 16, 1999 (filed Nov. 27, 1996)	Ex. 1010

D. Asserted Grounds of Unpatentability

Cox challenges claims 1–22 of the '714 patent based on the asserted grounds of unpatentability (“grounds”) set forth in the table below. Pet. 3–4, 20–59.

Reference(s)	Basis	Challenged Claim(s)
Blumhardt	§ 102(e)	1–5, 7, 13–15, 17, and 22
Blumhardt and Boulware	§ 103(a)	8, 9, 18, and 19
Blumhardt, Boulware, and Bayless ¹	§ 103(a)	10
Blumhardt and Beck	§ 103(a)	14, 15, 21, and 22
Buhrmann	§ 102(e)	1–7, 12–17, and 20
Buhrmann and Boulware	§ 103(a)	8, 9, 18, and 19
Buhrmann, Boulware, and Bayless ²	§ 103(a)	10

¹ Cox contends that dependent claim 10 is unpatentable under § 103(a) over the combination of Blumhardt and Bayless. Pet. 3, 20–30. Cox, however, contends that dependent claim 9, from which claim 10 depends, is unpatentable under § 103(a) over the combination of Blumhardt and Boulware. *Id.* Because Boulware is part of the ground asserted against dependent claim 9, we presume that Cox intended to assert that dependent claim 10 is unpatentable under § 103(a) over the combination of Blumhardt, Boulware, and Bayless.

² Cox contends that dependent claim 10 is unpatentable under § 103(a) over the combination of Buhrmann and Bayless. Pet. 3–4, 31–40. Cox, however, contends that dependent claim 9, from which claim 10 depends, is unpatentable under § 103(a) over the combination of Buhrmann and Boulware. *Id.* Because Boulware is part of the ground asserted against dependent claim 9, we presume that Cox intended to assert that dependent claim 10 is unpatentable under § 103(a) over the combination of Buhrmann, Boulware, and Bayless.

Reference(s)	Basis	Challenged Claim(s)
Buhrmann and Beck	§ 103(a)	14, 15, 21, and 22
An	§ 102(e)	1–7, 11, and 13–17
An and Bayless	§ 103(a)	10
An and Beck	§ 103(a)	14, 15, 21, and 22
Elliott	§ 102(e)	1–7, 13–17, and 22
Elliott and Bayless	§ 103(a)	10
Elliott and Beck	§ 103(a)	14, 15, 21, and 22

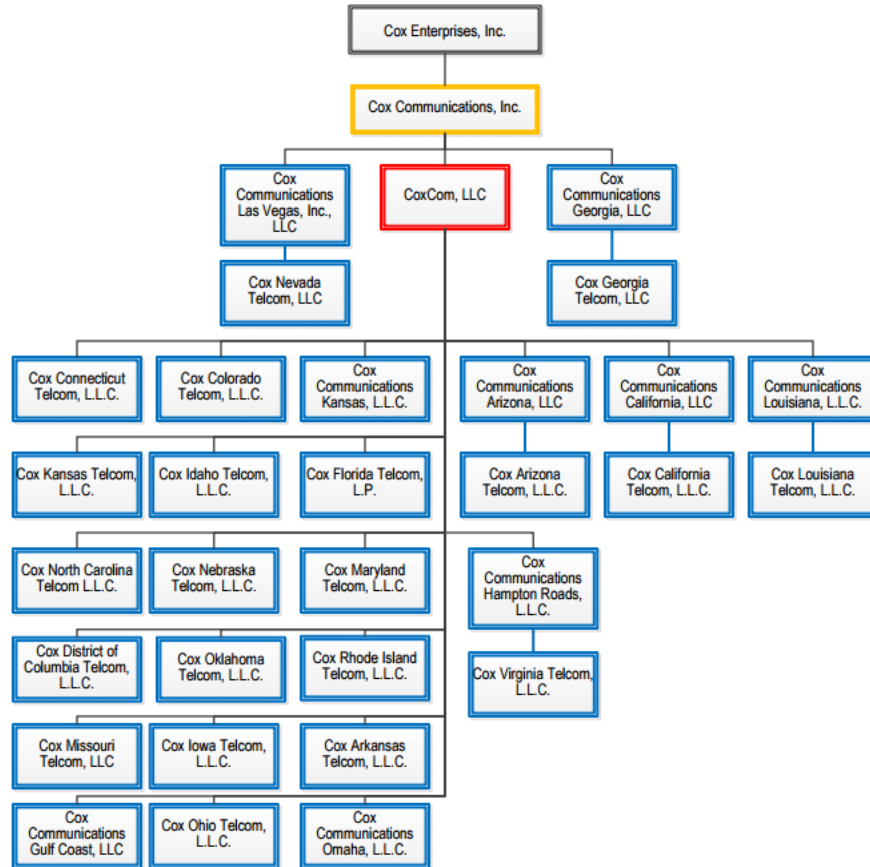
II. ANALYSIS

A. *Real Parties-in-Interest*

In its Petition, Cox certifies that it is the sole real party-in-interest in this proceeding. Pet. 1. In response, AT&T contends that the Petition should be denied for failing to name all real parties-in-interest, as required by 35 U.S.C. § 312(a)(2). Prelim. Resp. 9. AT&T argues that Cox should have identified its regional subsidiary entities as real parties-in-interest because these subsidiaries are co-defendants in the related district court case and ultimately perform the acts accused of infringing the '714 patent. *Id.* AT&T also argues that Cox should have identified its wholly-owned subsidiary, CoxCom, LLC, because the lines of corporate separation between these entities are blurred, and CoxCom, LLC has the opportunity to exercise control over Cox with respect to this proceeding. *Id.*

For convenience, AT&T provides us with a diagram that illustrates the corporate relationships between Cox, CoxCom, LLC, and its regional subsidiaries. Prelim. Resp. 13 (citing Ex. 2006). This diagram, reproduced

below, is helpful in determining whether Cox identifies all real parties-in-interest in the Petition in accordance with § 312(a)(2).



Ex. 2006.

We begin our analysis by providing the principles of law that generally apply to identifying a real party-in-interest in a given proceeding, and then we address AT&T’s contentions directed to Cox’s regional subsidiary entities and CoxCom, LLC in turn.

1. Principles of Law

The Practice Guide explains that whether a particular entity is a real party-in-interest is a “highly fact-dependent question” that is assessed “on a case-by-case basis.” *Office Patent Trial Practice Guide*, 77 Fed. Reg.

48,756, 48,759 (Aug. 14, 2012) (citing *Taylor v. Sturgell*, 553 U.S. 880, 893–95 (2008)). Although multiple factors may be relevant to the inquiry, “[a] common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Id.*; see also *Zoll Lifecor Corp. v. Phillips Elec. North Am. Corp.*, Case IPR2013-00609, slip op. at 10 (PTAB Mar. 20, 2014) (Paper 15) (stating the same).

2. Cox’s Regional Entities

AT&T contends that Cox owns CoxCom, LLC, which, in turn, owns all but four of Cox’s regional subsidiary entities—namely, Cox Communications Georgia, LLC, Cox Georgia Telcom, LLC, Cox Communications Las Vegas, Inc., LLC, and Cox Nevada Telcom, LLC. Prelim. Resp. 15. AT&T argues that Cox’s regional subsidiaries deliver goods and services to consumers—not Cox. *Id.* at 15–16 (citing Ex. 2003, 4, 6, 12; Ex. 2008 ¶ 6; Ex. 2011, 5–6). AT&T further argues that, because the regional subsidiaries deliver goods and services to consumers, they infringe the ’714 patent. *Id.* at 16 (citing Ex. 2003, 6; Ex. 2011, 4; Ex. 2012, 3, 16–17). AT&T then argues that Cox did not file the Petition on its own accord, but rather filed the Petition as a surrogate representing the interests of the regional subsidiaries. *Id.* at 17. For these reasons, AT&T asserts that Cox’s regional subsidiaries should have been identified as real parties-in-interest in the Petition. *Id.*

As evidenced by the diagram reproduced above (Ex. 2006), Cox is the parent entity of all the regional subsidiaries, as well as CoxCom LLC. Given this parent-child relationship, it is not clear to us how the regional subsidiaries control, direct, or fund Cox’s participation in this proceeding, and AT&T has not provided evidence sufficient to support such an assertion.

At most, AT&T has shown that Cox and its regional subsidiaries are joint defendants in the related district court case and, as a result, they share a common interest in rendering the subject matter of the challenged claims unpatentable. This common interest, however, is not enough to demonstrate that Cox's regional subsidiaries should have been identified as real parties-in-interest in the Petition. *See* 77 Fed. Reg. at 48,759–60 (A party is not considered a real party-in-interest in an *inter partes* review solely because it is a defendant with a petitioner in a patent infringement suit or, alternatively, is part of a joint defense group with a petitioner in the suit); *see, e.g., Denso Corp. v. Beacon Navigation GmbH*, Case IPR2013-00026, slip op. at 10–11 (PTAB Mar. 14, 2014) (Paper 34).

3. CoxCom, LLC

AT&T contends that, based on a draft stipulation in the related district court case, CoxCom, LLC directs certain actions taken by Cox and the regional subsidiaries. Prelim. Resp. 17 (citing Ex. 2007, 1, 3). AT&T further argues that, in at least two other district court cases, Cox stipulated to replacing itself with CoxCom, LLC as the defendant in those litigations. *Id.* at 19 (citing Exs. 2013, 2014). Based on these stipulations, as well as other circumstantial evidence, AT&T asserts that CoxCom, LLC controls or has the ability to control the actions taken by Cox in this proceeding. *Id.* (citing Ex. 2007, 3–5).

AT&T then proceeds to direct us to other circumstantial evidence that purportedly demonstrates how Cox blurs the lines of corporate separation with CoxCom, LLC. For instance, AT&T argues that, in other petitions filed with the Board, Cox has taken inconsistent positions as to whom it identifies as a real party-in-interest in each petition. Prelim. Resp. 20–23

(citing Ex. 2020). AT&T also argues that there is significant overlap in the corporate leadership of Cox and CoxCom, LLC. *Id.* at 23–24 (citing Ex. 2023). Based on this circumstantial evidence, AT&T asserts that CoxCom, LLC may influence Cox’s actions and, as a result, CoxCom, LLC should have been identified as a real party-in-interest in the Petition. *Id.* at 25–26.

As we explained previously, Cox is the parent entity of CoxCom, LLC. Ex. 2006. Given this parent-child relationship, it is not clear to us how CoxCom, LLC controls, directs, or funds Cox’s participation in this proceeding. With this relationship in mind, we address AT&T’s arguments directed to CoxCom, LLC in turn.

We are not persuaded by AT&T’s argument that the draft stipulation in the related district court case (Ex. 2007), along with Cox’s stipulation to have CoxCom, LLC replace Cox as the defendant in two other unrelated district court cases (Exs. 2013, 2014), establishes that CoxCom, LLC controls or could exercise control over Cox’s participation in this proceeding. For example, although the first paragraph in the stipulation of Exhibit 2013 indicates that Cox is a non-operational holding company, there could have been any number of reasons for Cox to have entered into such a stipulation. AT&T does not provide sufficient evidence, much less explain adequately how these stipulations indicate that CoxCom, LLC exercises control over Cox’s actions in the present matter.

We also are not persuaded by AT&T’s argument that Cox has taken inconsistent positions as to who it identifies as a real party-in-interest in other petitions filed with the Board. Ex. 2020. Although troubling, such inconsistent positions do not demonstrate necessarily that CoxCom, LLC

controls or could exercise control over Cox's participation in this proceeding, particularly in view of the parent-child relationship between Cox and CoxCom, LLC (Ex. 2006). We recognize that there may be circumstances that create an exception to Cox's presumptive control over its wholly-owned subsidiary CoxCom, LLC. Based on the present record, however, AT&T has not provided sufficient evidence, much less explained adequately how this case might qualify as such an exception.

Finally, we are not persuaded by AT&T's argument regarding the significant overlap in the corporate leadership of Cox and CoxCom, LLC. Ex. 2023. AT&T readily admits that this overlap is based on speculation due to the fact that the Cox companies are held privately and there is minimal visibility into corporate leadership. Prelim. Resp. 23 n.5. Such speculation or conjecture is not enough to demonstrate that CoxCom, LLC should have been identified as a real party-in-interest in the Petition. At most, AT&T may have established that some of Cox's employees serve similar roles in the management of other subsidiaries within its corporate structure. Moreover, AT&T does not assert that this overlap in corporate leadership is uncommon in large corporations, nor does AT&T provide credible or sufficient evidence that a particular employee of CoxCom, LLC wields a significant degree of control over Cox's participation in this particular proceeding.

4. Summary

At this juncture of the proceeding, and based on the present record, we are not persuaded by AT&T's argument that the Petition should be denied for failure to name all real parties-in-interest, as required by § 312(a)(2).

B. Claim Construction

In an *inter partes* review, we construe claims by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *see In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015). Under the broadest reasonable interpretation standard, and absent any special definitions, claim terms or phrases are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art, in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. Alleged Defective Petition Under 37 C.F.R. § 42.104(b)(3)

AT&T alleges that Cox has failed to meet the regulatory requirements for a petition because it did not identify specifically in the Petition any proposed construction for any claim term of the '714 patent. Prelim. Resp. 29 (citing 37 C.F.R. § 42.104(b)(3)). AT&T further argues that, because the Petition does not even provide a statement that the claims terms are to be given their broadest reasonable interpretation, it fails to provide the “bare minimum” statement suggested by the *Office Patent Trial Practice Guide*. *Id.* at 29–30 (citing 77 Fed. Reg. at 48,764). On this basis, AT&T requests that the Petition be dismissed for failure to comply with § 42.104(b)(3). *Id.* at 30.

We decline to dismiss the Petition on this basis. There is a “heavy presumption” that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). AT&T does not allege that the challenged claims include means-plus-function or step-plus-function limitations that would invoke 35 U.S.C. § 112 ¶ 6 and require identification of specific portions of the specification that

describe the structure, material, or acts corresponding to each claimed function. 37 C.F.R. § 42.104(b)(3). Under these circumstances, we do not view Cox’s failure to include a statement concerning claim interpretation in its Petition as mandating dismissal under § 42.104(b)(3).

2. *“subscriber profile data . . . the subscriber profile data being stored on a communication network which executes the communications service in accordance with the subscriber profile data . . .”*
(Preamble of Claim 1)

In the Petition, Cox does not present arguments or evidence as to whether the preamble of independent claim 1 is entitled to patentable weight. AT&T, however, contends that certain portions of the preamble of independent claim 1 are entitled to patentable weight because they recite limitations and provide antecedent basis for certain claim terms or phrases found in the body of this claim. Prelim. Resp. 28. In particular, AT&T refers to the preamble of independent claim 1 that recites, in relevant part, that the “subscriber profile data” is “stored on a communications network which executes the communications service in accordance with the subscriber profile data.” *Id.* AT&T argues that these recitations in the preamble offer a distinct requirement for the claimed invention—namely, that the subscriber profile data is stored on a communications network, which, in turn, executes a communications service in accordance with the subscriber profile data. *Id.* at 28–29. AT&T further argues that the recitation of “subscriber profile data” in the preamble of independent claim 1 provides antecedent basis for the same claim phrase found in the body of this claim. *Id.* at 29.

In considering whether a preamble limits a claim, the preamble is analyzed to ascertain whether it states a necessary and defining aspect of the invention, or whether it is simply an introduction to the general field of the claim. *On Demand Machine Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1343 (Fed. Cir. 2006); *see also Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (whether a preamble limits a claim is determined on a claim-by-claim basis). A preamble is construed as a limitation “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). A preamble, however, is not limiting “‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’” *Id.* (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)).

For purposes of this decision, we agree with AT&T that the aforementioned recitations in the preamble of independent claim 1 are entitled to patentable weight because they state necessary and defining aspects of the invention embodied in this challenged claim. Indeed, “when the limitations in the body of the claim ‘rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention.’” *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003). Here, the recitations in the preamble of “subscriber profile data” and “a communications network” provide antecedent basis for the same claim phrases recited in the body of independent claim 1. We also view the recitation in the preamble of “the

subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data” as reciting essential elements of the invention embodied in independent claim 1—namely, the storage and execution of the “subscriber profile data.”

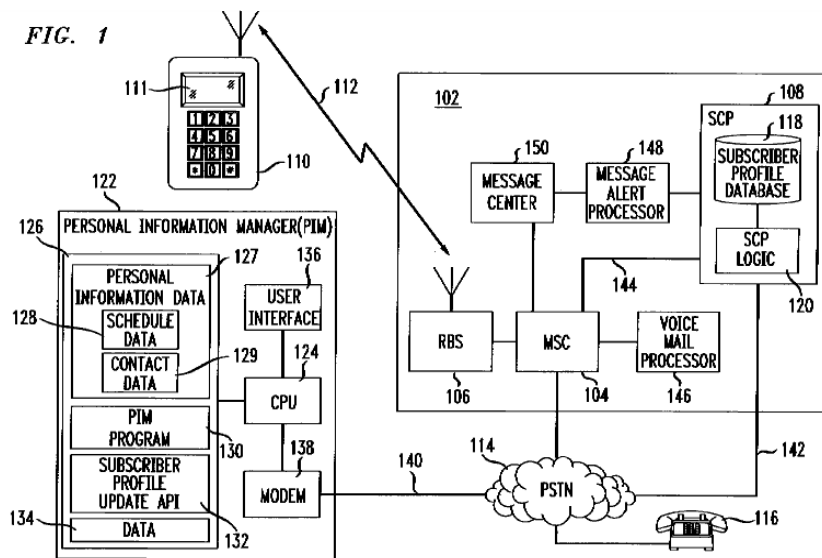
C. Anticipation by Buhrmann

Cox contends that claims 1–7, 12–17, and 20 are anticipated under § 102(e) by Buhrmann. *See* Pet. 31–40. Cox explains how Buhrmann describes the subject matter of each challenged claim (*id.*), and relies upon the Declaration of Professor Nader F. Mir, Ph.D. (Ex. 1014) to support its positions. Based on the present record, we are persuaded by Cox’s explanations and supporting evidence.

We begin our analysis with an overview of Buhrmann, and then we turn to the parties’ contentions with respect to the challenged claims.

1. Buhrmann Overview

Buhrmann generally relates to personal information managers (“PIMs”) and, in particular, to updating a telecommunication subscriber profile based on information entered into a PIM. Ex. 1004, 1:13–17. Figure 1 of Buhrmann, reproduced below, illustrates a system for updating a telecommunication subscriber profile via a wired communication link and for providing telecommunications services based on the updated subscriber profile. *Id.* at 4:51–54, 5:13–15.



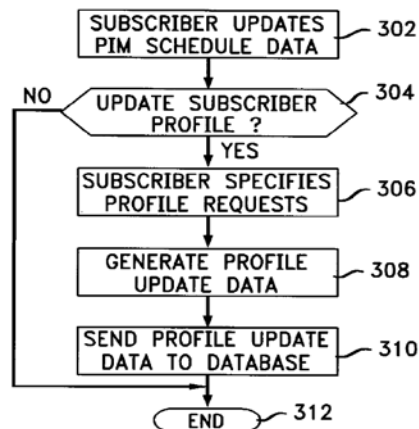
As shown in Figure 1 of Buhrmann, wireless cellular communication network 102 includes mobile switching center (“MSC”) (104), radio base station (“RBS”) (106), service control point (“SCP”) (108), voice mail processor (146), message center (150), and message alert processor (148). Ex. 1004, 5:15–20. Mobile station 110 communicates with RBS 106 via radio communication link 112. *Id.* at 5:20–22. SCP 108 contains both database 118, which stores subscriber profiles, and SCP logic 120, which is a computer processor executing stored program instructions in a manner that is old and well known in the art. *Id.* at 5:57–62.

Buhrmann further discloses that a prospective user may use PIM 122 to update its subscriber profile record stored in database 118. Ex. 1004, 6:37–39. PIM 122 includes central processing unit 124 connected to memory 126, user interface 136, and modem 138. *Id.* at 6:46–49. Memory 126 contains storage areas for storing personal information data 127, PIM program 130, subscriber profile update application program interface 132, and other data 134. *Id.* at 6:49–52. According to Buhrmann, personal information data 127 includes schedule data 128 and contact data 129 that is

associated with the updated subscriber profile data stored in database 118.
See id. at Abstract, 6:52–53.

Figure 3 of Buhrmann, reproduced below, illustrates a flowchart of the steps of generating data for use in updating a subscriber profile stored in database 118. Ex. 1004, 4:55–57, 7:25–28.

FIG. 3



As shown in step 302 of Figure 3, Buhrmann discloses that the subscriber updates schedule data 128, which is part of personal information data 127, via user interface 136 on PIM 122. Ex. 1004, 7:33–36; Fig. 4. At step 304, upon entry of schedule data 128 (“the PIM entry”), PIM 122 queries the subscriber as to whether it would like to update his/her telecommunication subscriber profile based on the PIM entry. *Id.* at 7:55–60. At step 306, if the subscriber answers “Yes” to this query, the subscriber enters the profile request into PIM 122. *Id.* at 7:62–64. At step 308, after the subscriber enters and confirms the profile request, PIM 122 generates profile update data appropriate for updating its subscriber profile stored in database 118. *Id.* at 8:37–40, Fig. 5. At step 310, PIM 122 transmits the profile update data to database 118 located in wireless cellular communication network 102. *Id.* at 9:14–22.

2. Claim 1

Cox contends that Buhrmann describes all the limitations recited in independent claim 1. Pet. 33–35. In particular, Cox argues that Buhrmann’s PIM 122 allows a subscriber to view, enter, and update personal information data 127 associated with the subscriber’s profile stored in database 118. *Id.* at 34 (citing Ex. 1004, 6:37–53, 7:13–39, 8:4–14, Figs. 1, 3–5; Ex. 1014 ¶ 80); *see also id.* at 13–14 (arguing the same). Based on these arguments, we understand Cox to assert that Buhrmann’s subscriber profiles stored in database 118 constitutes the claimed “subscriber profile data,” and Buhrmann’s wireless cellular communication network 102 constitutes the claimed “communications network.”

In response, AT&T contends that Cox fails to identify any disclosure in Buhrmann that describes the portions of the preamble in independent claim 1 that we have accorded patentable weight. Prelim. Resp. 39. In particular, AT&T asserts that Cox’s summary of Buhrmann does not account properly for a communications network that “executes the communications service in accordance with the subscriber profile data,” as recited in the preamble of independent claim 1. *Id.* at 39–40.

In our claim construction section above, we agree with AT&T that the recitation in the preamble of “the subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data” recites essential elements of the invention embodied in independent claim 1 and, therefore, should be accorded patentable weight. *See supra* Section II(B)(2). Figure 1 of Buhrmann illustrates that the subscriber profiles are stored in database 118 located in wireless cellular communication network 102. Ex. 1004, Fig. 1.

The parties' dispute, therefore, centers on whether Buhrmann's wireless cellular communication network 102 executes a communications service in accordance with the subscriber profiles stored in database 118.

As we explained previously, Cox relies extensively on Figure 1 of Buhrmann throughout its overview of Buhrmann and in its corresponding claim chart. *See* Pet. 12–15, 33–35. Figure 1 of Buhrmann illustrates that wireless cellular communication network 102 includes, among other things, SCP (108). Ex. 1004, 5:15–20. SCP 108 contains two components—(1) database 118; and (2) SCP logic 120, which is a computer processor executing stored program instructions in manner that is old and well known in the art. *Id.* at 5:57–62. Based on these cited disclosures, we understand Cox to assert that Buhrmann's SCP 108 located in wireless cellular communication network 102 is instrumental in executing a communications service (*see, e.g. id.* at 1:20–67 (“call completion,” “call forwarding,” and “alert reminders”)) in accordance with the subscriber profiles stored on database 118. Pet. 31, 33–35. Consequently, we are persuaded that Cox has presented sufficient evidence to support an argument that Buhrmann describes that wireless cellular communication network 102 “executes the communications service in accordance with the subscriber profile data,” as recited in the preamble of independent claim 1.

Next, AT&T contends that Buhrmann does not disclose “retrieving the subscriber profile data from the communications network . . . ,” as recited in independent claim 1. Prelim. Resp. 40. AT&T argues that Buhrmann does not disclose retrieving any data, much less subscriber profile data, from database 118, SCP 108, or any other portion of wireless cellular communication network 102. *Id.* at 40–42 (citing Ex. 1004, Abstract,

Fig. 1). AT&T further argues that Cox only relies upon Buhrmann's disclosure of using PIM 122 to view, enter, and update personal information data 127. *Id.* at 42. AT&T, however, asserts that Buhrmann's personal information data 127 does not amount to subscriber profile data stored in database 118. *Id.* AT&T also asserts that Buhrmann only discloses transmitting information from PIM 122 to SCP 108 and not retrieving subscriber profile data via SCP 108 from database 118. *Id.* at 42–43 (citing Ex. 1004, 7:13–22).

On this record, we are not persuaded by AT&T's argument that Buhrmann's personal information data 127 does not amount to subscriber profile data. Buhrmann discloses that personal information data 127 is associated with updated subscriber profile data. Ex. 1004, Abstract. For instance, Buhrmann discloses that personal information data 127 includes schedule data 128 and contact data 129. *Id.* at 6:52–53. As Cox explains in its Petition, schedule data 128 and contact data 129 are the types of data illustrated in Figures 4 and 5 of Buhrmann that may be used to update a subscriber's profile stored in database 118. Pet. 34–35 (citing Figs. 4, 5).

We also are not persuaded by AT&T's argument that Buhrmann only discloses transmitting information from PIM 122 to SCP 108 and not retrieving subscriber profile data via SCP 108 from database 118. AT&T narrowly focuses on a select sentence of Buhrmann's disclosure of using modem 138 for "sending" information from PIM 122 to SCP 108 through public switched telephone network 114. Ex. 1004, 7:21–22. The next sentence in Buhrmann, however, discloses that using a modem for "communication with external devices" is old and well known. *Id.* at 7:22–24. In our view, the function of a conventional modem is not limited to just

transmitting information, but also includes receiving information as part of the communication function. *See EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985) (A prior art reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect.)

Moreover, AT&T either ignores, or fails to appreciate, other disclosures in Buhrmann that would support a finding that PIM 122 retrieves subscriber profile data from database 118. For instance, as Cox explains in relation to the steps of updating a subscriber profile illustrated in Figure 3 of Buhrmann, Figures 4 and 5 of Buhrmann illustrate that PIM 122 retrieves schedule data 128 and contact data 129, which, as we explained above, is associated with a particular subscriber's profile. Pet. 34–35 (citing Figs. 4, 5). Consequently, we are persuaded that Cox has presented sufficient evidence that would support a finding that Buhrmann describes “retrieving the subscriber profile data from the communications network . . . ,” as recited in independent claim 1.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that independent claim 1 is anticipated by Buhrmann.

3. *Claim 13*

Cox contends that Buhrmann describes all the limitations recited in independent claim 13. Pet. 37–38. Cox relies upon essentially the same findings with respect to independent claim 1 to support its assertion that independent claim 13 is anticipated by Buhrmann. *Compare id.* at 33–35, *with id.* at 37–38.

In response, AT&T contends that Buhrmann does not describe “receiving, from a profile management system, a subscriber request to view the subscriber profile data,” as recited in independent claim 13. Prelim. Resp. 44. AT&T argues that it unclear what element or combination of elements Cox identifies as the claimed “profile management system.” *Id.*

As Cox explains in its Petition, Buhrmann’s PIM 122 allows a subscriber to view, enter, and update personal information data 127 associated with the subscriber’s profile stored in database 118. Pet. 34 (citing Ex. 1004, 6:37–53, 7:13–39, 8:4–14, Figs. 1, 3–5; Ex. 1014 ¶ 80); *see also id.* at 37 (arguing the same). We understand Cox to assert that Buhrmann’s PIM 122 constitutes the claimed “profile management system” because a subscriber uses PIM 122 to request its subscriber profile data from database 118. Consequently, we are persuaded that Cox has presented sufficient evidence that would support a finding that Buhrmann describes “receiving, from a profile management system, a subscriber request to view the subscriber profile data,” as recited in independent claim 13.

Next, AT&T contends that Buhrmann does not describe “the communications network executes the communications service in accordance with the updated subscriber profile data,” as recited in independent claim 13. Prelim. Resp. 45. According to AT&T, Cox makes no showing that Buhrmann describes this limitation.

In our analysis above with respect to independent claim 1, we understand Cox to argue that Buhrmann’s SCP 108 located in wireless cellular communication network 102 is instrumental in executing a communications service in accordance with the subscriber profiles stored on database 118. *See* Pet. 12–15, 33–35, 37–38; Ex. 1004, 5:15–20, 5:57–62.

Consequently, we are persuaded that Cox has presented sufficient evidence that would support a finding that Buhrmann describes that “the communications network executes the communications service in accordance with the updated subscriber profile data,” as recited in independent claim 13.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that independent claim 13 is anticipated by Buhrmann.

4. Claims 2–7, 12, 14–17, and 20

At this juncture in the proceeding, AT&T does not address separately Cox’s explanations and supporting evidence regarding challenged claims 2–7, 12, 14–17, and 20. *See generally* Prelim. Resp. 39–45. Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that these claims are anticipated by Buhrmann.

D. Obviousness Based, in Part, on Buhrmann

Cox contends that: (1) claims 8, 9, 18, and 19 are unpatentable under § 103(a) over the combination of Buhrmann and Boulware; (2) claim 10 is unpatentable over the combination of Buhrmann, Boulware, and Bayless; and (3) claims 14, 15, 21, and 22 are unpatentable over the combination of Buhrmann and Beck. *See* Pet. 31–40. Cox explains how these proffered combinations teach the subject matter of each challenged claim (*id.*), and relies upon the Declaration of Dr. Mir (Ex. 1014) to support its positions. Based on the present record, we are persuaded by Cox’s explanations and supporting evidence.

We begin our analysis with overviews of Boulware, Bayless, and Beck, and then we turn to the parties' contentions with respect to each asserted ground.

1. Boulware Overview

Boulware generally relates to a telephone call screening system and, in particular, to a call screening system that includes subscriber call screen activation schedules, as well as call screening deactivation timers. Ex. 1008, 1:11–14. According to Boulware, when a deactivation timer expires, the call screening service automatically reverts to the subscriber's schedule. *Id.* at 1:14–15. Boulware further discloses a privileged caller code that allows a caller to be routed directly to a subscriber regardless of the status of the call screening service. *Id.* at 4:5–10. The privileged caller code is stored as part of the caller or subscriber's profile data, which, in turn, may reside on any one of a number of SCPs. *Id.* at 5:5–20

2. Bayless Overview

Bayless generally relates to telecommunication systems and, in particular, to software and telephone systems that may use personal computers to perform telephone operations. Ex. 1009, 1:11–14. Bayless discloses that the software may log information about each call generated or received by a user. *Id.* at 60:36–38. This information, which includes time stamps of when the call began, whether the call went to voicemail, the time duration of the voicemail message, the parties to the call, etc. may be stored in a call log database. *Id.* at 60:38–41, 60:50–55, 60:60–63.

3. Beck Overview

Beck generally relates to customized telecommunications services and, in particular, to providing an interface between a service management

system that embodies the telecommunications services and a service activation controller that receives and enters service orders. Ex. 1010, 1:34–39. In particular, Beck discloses a system for processing a provisioning message that includes service management system 250, which, in one embodiment, operates as Bellcore’s Service Provisioning and Creating Environment (“SPACE”) system. *Id.* at 4:25–33, Figs. 2, 3.

*4. Obviousness Based on the Combination of Buhrmann and Boulware—
Claims 8, 9, 18, and 19*

Cox contends that Buhrmann teaches all the limitations of dependent claims 8, 9, 18, and 19, except “access codes” and “the calling party inputs one of the access codes.” Pet. 36, 39–40 (citing Ex. 1004, 8:20–26, Fig. 5). Cox relies upon Boulware as teaching these limitations. *Id.* (citing Ex. 1008, 4:5–19, 5:5–24, Fig. 1). Cox also provides a rationale to combine the teachings of Buhrmann and Boulware. *Id.* at 32. In particular, Cox contends that, “[b]ecause Buhrmann provides a system designed to modify telephone services, a skilled artisan would be readily motivated to incorporate the known telephone screening service of Boulware with the known system of Buhrmann to yield a predictable improvement of available services.” *Id.* (citing Ex. 1014 ¶ 86; Manual of Patent Examining Procedure (“MPEP”) §§ 2143–44) (emphasis omitted).

In response, AT&T contends that Cox’s rationale to combine the teachings of Buhrmann and Boulware is nothing more than a conclusory statement. Prelim. Resp. 46. AT&T argues that Cox provides no objective evidence of a predictable improvement, nor does it expert witness, Dr. Mir, supply such evidence. *Id.*

The Supreme Court has held that an obviousness evaluation “cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Instead, the relevant inquiry is whether Cox has set forth “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), *cited with approval in KSR*, 550 U.S. at 418.

On this record, we are persuaded that Cox’s rationale for combining the teachings of Buhrmann and Boulware suffices as an articulated reasoning with a rational underpinning that would support the legal conclusion of obviousness. The Supreme Court has held that, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *See KSR*, 550 U.S. at 417. This principle supports Cox’s argument and evidence that one of ordinary skill in the art would have incorporated Boulware’s known telephone screening service, particularly its access codes, into Buhrmann’s telecommunication system. *See* Pet. 32 (citing Ex. 1014 ¶ 86).

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that dependent claims 8, 9, 18, and 19 would have been obvious over the combination of Buhrmann and Boulware.

5. *Obviousness Based on the Combination of Buhrmann, Boulware, and Bayless—Claim 10*

Dependent claim 10 recites, in relevant part, “a reporting system generates reports comprising calling parties attempting to connect to the subscriber, indicating each calling party successfully connected to the subscriber and each calling party not successfully connected to the subscriber.” Cox relies upon Bayless as teaching this limitation. Pet. 36–37 (citing Ex. 1009, 60:35–41, 60:52–55, 60:60–63, 61:4–15, Fig. 111). Cox also provides a rationale to combine the teachings of Buhrmann and Boulware, as well as a rationale to combine the teachings of Buhrmann and Bayless. *Id.* at 32. Cox’s rationale to combine the teachings of Buhrmann and Boulware is reproduced above. *See supra* II(D)(4). To support its rationale to combine the teachings of Buhrmann and Bayless, Cox contends that, “[b]ecause Buhrmann provides a system designed to modify a variety of telephone services, a skilled artisan would be readily motivated to incorporate the known telephone call logging feature of Bayless with the known system of Buhrmann to yield a predictable improvement of available services.” *Id.* (citing Ex. 1014 ¶ 91; MPEP §§ 2143–44) (emphasis omitted).

In response, AT&T contends that Cox does not provide any evidence to support its rationale to combine the teachings of Buhrmann and Bayless. Prelim. Resp. 47. AT&T asserts that “‘rejections on obviousness cannot be sustained with mere conclusory statements’” *Id.* (quoting *Kahn* 441, F.3d at 988).

On this record, we are persuaded that Cox’s rationales for combining the teachings of Buhrmann, Boulware, and Bayless each suffice as an articulated reasoning with a rational underpinning that would support the

legal conclusion of obviousness. Focusing solely on Cox’s rationale to combine the teachings of Buhrmann and Bayless, *KSR* again supports Cox’s argument and evidence that one of ordinary skill in the art would have incorporated Bayless’s known telephone logging feature, particularly its ability to log information about each call generated or received by a user, into Buhrmann’s telecommunication system. *See* Pet. 32 (citing Ex. 1014 ¶ 91); *KSR*, 550 U.S. at 417.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that dependent claim 10 would have been obvious over the combination of Buhrmann, Boulware, and Bayless.

*6. Obviousness Based on the Combination of Buhrmann and Beck—
Claims 14, 15, 21, and 22*

Dependent claims 14 and 15 recite, in relevant part, “the subscriber profile data is forwarded to the profile management system via at least one intermediate system,” and “the update for the subscriber profile data is received from the profile management system via at least one intermediate system.” Cox relies upon the combination of Buhrmann and Beck to teach these limitations. Pet. 38–39 (citing Ex. 1004, 7:13–22, 10:20–27, Figs. 1, 7; Ex. 1014 ¶ 81; Ex. 1010, 4:27–31, 4:47–48, 4:53–64, Figs. 2, 3).

Dependent claims 21 and 22 recite, in relevant part, “the intermediate system further comprises SPACE,” and “the profile management system communicates with the client using TCP/IP.” Cox relies upon Beck as teaching these limitations. *Id.* at 40 (citing Ex. 1010, 1:55–57, 4:16–18, 4:27–33, 4:53–64, Figs. 2, 3).

Cox also provides a rationale to combine the teachings of Buhrmann and Beck. Pet. 32–33. In particular, Cox contends that, “[b]ecause Buhrmann and Beck have similar system architectures and are designed to perform user service management, a skilled artisan would be readily motivated to incorporate the known intermediate SPACE service management system of Beck with the known system of Buhrmann to yield a predictable improvement of the service management system.” *Id.* at 33 (citing Ex. 1014 ¶ 96; MPEP §§ 2143–44) (emphasis omitted).

In response, AT&T contends that Cox does not provide any objective evidence that supports its rationale to combine the teachings of Buhrmann and Beck, much less a reason from Dr. Mir to support its conclusion of obviousness. Prelim. Resp. 47–48. AT&T asserts that, once again, Cox provides a rationale to combine the teachings of Buhrmann and Beck that is nothing more than a conclusory statement. *See id.*

On this record, we are persuaded that Cox’s rationale for combining the teachings of Buhrmann and Beck suffices as an articulated reasoning with a rational underpinning that would support the legal conclusion of obviousness. *KSR* again supports Cox’s argument and evidence that one of ordinary skill in the art would have incorporated the known intermediate SPACE service management system, as taught by Beck, into Buhrmann’s telecommunication system. *See* Pet. 33 (citing Ex. 1014 ¶ 96); *KSR*, 550 U.S. at 417.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that dependent claims 14, 15, 21, and 22 would have been obvious over the combination of Buhrmann and Beck.

E. Anticipation by An

Cox contends that claims 1–7, 11, and 13–17 are anticipated under § 102(e) by An. *See* Pet. 40–52. Cox explains how An describes the subject matter of each challenged claim (*id.*), and relies upon the Declaration of Dr. Mir (Ex. 1014) to support its positions. Based on the present record, we are persuaded by Cox’s explanations and supporting evidence.

We begin our analysis with an overview of An, and then we turn to the parties’ contentions with respect to the challenged claims.

1. An Overview

An generally relates to configuring different telephone feature profiles for different subscribers and, in particular, to a system that permits a subscriber to add, change, or delete features with respect to his/her particular telephone feature profile. Ex. 1005, 1:12–16. Figure 16 of An, reproduced below, illustrates a high-level walk through of the embodiment illustrated in Figure 15. *Id.* at 2:61–62, 8:50–52.

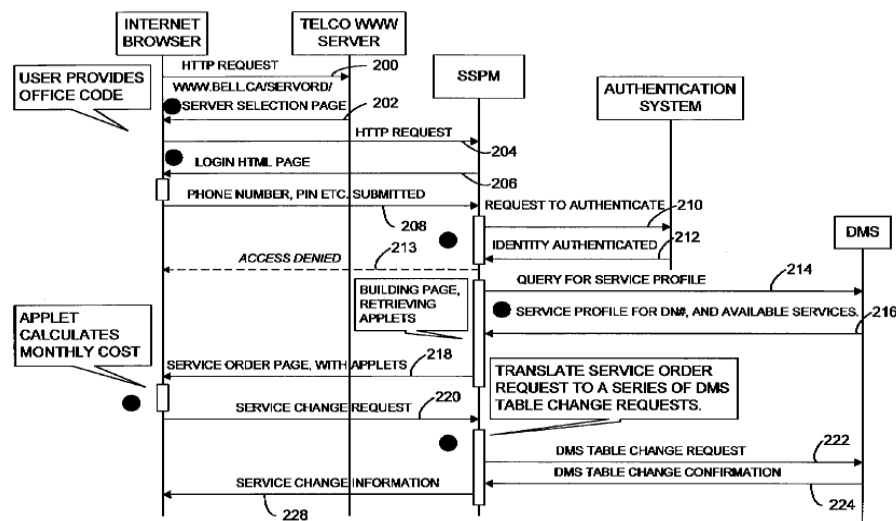


FIGURE 16

Of particular importance to this case are steps 214–222 illustrated in Figure 16 of An, reproduced above. Ex. 1005, Fig. 16. At step 214, a user

employing an Internet browser sends a query to digital multiplexed switch (“DMS”) for the feature profile of a particular directory number (“DN”) entered by the user. *Id.* at 9:6–8. This query may be done directly through a subscriber service provisioning manager (“SSPM”). *Id.* at 9:8–10. At step 216, DMS sends back the service profile for the DN entered, as well as a list of available services. *Id.* at 9:10–12. At step 218, the SSPM uses this information to build a customized web page and then sends the customized webpage to the user’s Internet browser. *Id.* at 9:12–18. At step 220, when the user makes a change to the feature profile associated with the DN retrieved, it sends the SSPM a response that activates a “request processing” application. *Id.* at 9:21–23. At step 222, this service order request is translated into a series of DMS table change requests that are sent to the DMS over the telephone company intranet. *Id.* at 9:23–26.

An discloses that the tables stored on the DMS contain “tuples” that indicate features active for a given DN. Ex. 1005, 8:21–22. Typical features available to subscribers include “call forward, call waiting, ring again, speed call, message waiting, 3-way conferencing, softkey programming, and 800 services.” *Id.* at 3:15–19. These tables assume the role of the profile repositories for each user. *Id.* at 8:22–23. A tuple may be read, changed, deleted, or added to the tables stored on the DMS, thereby changing a user’s feature profile. *Id.* at 8:23–25.

2. Claim 1

Cox contends that An describes all the limitations recited in independent claim 1. Pet. 42–45. In particular, Cox argues that An discloses that a user employing an Internet browser may access and manipulate a feature profile associated with a given DN by querying the

DMS. *Id.* at 43 (citing 1005, 5:6–12, 9:6–8, Figs. 2–12, 16, Ex. 1014 ¶ 99); *see also id.* at 16 (arguing that DMS 160 illustrated in Figure 15 of An amounts to the claimed “communications network”). Based on these arguments, we understand Cox to assert that An’s feature profiles stored in the tables on the DMS constitutes the claimed “subscriber profile data,” whereas An’s DMS constitutes the claimed “communications network.”

In response, AT&T contends that Cox fails to identify any disclosures in An that properly account for the portions of the preamble of independent claim 1 that we have accorded patentable weight. Prelim. Resp. 49–50. That is, AT&T asserts that An does not describe “a communications network which executes the communications service in accordance with the subscriber profile data,” as recited in the preamble of independent claim 1. *Id.*

In our claim construction section above, we agree with AT&T that the recitation in the preamble of “the subscriber profile data being stored on a communications network which executes the communications service in accordance with the subscriber profile data” recites essential elements of the invention embodied in independent claim 1 and, therefore, should be accorded patentable weight. *See supra* Section II(B)(2). An discloses that feature profiles for each user are stored on tables in the DMS. Ex. 1005, 8:21–25, Figs. 15–16. The parties’ dispute, therefore, centers on whether An’s DMS executes a communications service in accordance with the feature profiles stored therein.

An’s corresponding description of Figures 15 and 16 indicates that the DMS is instrumental in executing certain aspects of An’s invention. *See, e.g.,* Ex. 1005, 8:10–13. Given that the DMS implements certain aspects of

An's invention, we recognize that the DMS must play at least some role in the execution of a communication service associated with a feature profile, e.g., call forwarding, call waiting, speed call, *et cetera*, because it stores the tables containing each feature profile. *Id.* at 8:21–25. In other words An's feature profiles must be accessed from the DMS before a communications services identified in each profile is executed. Consequently, we are persuaded that Cox has presented sufficient evidence that would support a finding that An describes “a communications network which executes the communications service in accordance with the subscriber profile data,” as recited in the preamble of independent claim 1.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that independent claim 1 is anticipated by An.

3. *Claim 13*

Cox contends that An describes all the limitations recited in independent claim 13. Pet. 48–50. Cox relies upon essentially the same findings with respect to independent claim 1 to support its assertion that independent claim 13 is anticipated by An. *Compare id.* at 42–45, *with id.* at 48–50.

AT&T contends that An does not describe “the communications network executes the communications service in accordance with the updated subscriber profile data,” as recited in independent claim 13. Prelim. Resp. 50. According to AT&T, Cox makes no showing that An describes this limitation. *Id.* at 50–51.

In our analysis above with respect to independent claim 1, we determined that Cox's reliance on the DMS, particularly the disclosure in An

that the DMS stores the tables containing feature profiles, was sufficient to demonstrate that the DMS plays at least some role in executing a communications service in accordance with each feature profile stored therein. *See* Pet. 15–17, 42–45, 48–50; Ex. 1005, 8:10–13, 8:21–25, Figs. 15, 16. Consequently, we are persuaded that Cox has presented sufficient evidence that would support a finding that An describes that “the communications network executes the communications service in accordance with the updated subscriber profile data,” as recited in independent claim 13.

Next, AT&T contends that Cox independent claim 13 requires “receiving an update for the subscriber profile data from the profile management system” Prelim. Resp. 51. AT&T argues that Cox has not demonstrated how An describes this limitation. *Id.*

As Cox explains in its Petition, An’s SSPM serves as a conduit between the user entering a service change request, i.e., an update, at an Internet browser and the DMS that stores tables containing the feature profiles. Pet. 44–45 (Ex. 1005, 5:22–34, 9:22–30, Figs. 2, 3, 16; Ex. 1014 ¶ 100); *see also id.* at 49–50 (arguing the same). We understand Cox to assert that An’s SSPM constitutes the claimed “profile management system” because it transmits a feature profile update to the DMS, albeit only after the user changes its feature profile using an Internet browser. Consequently, we are persuaded that Cox has presented sufficient evidence that would support a finding that An describes “receiving an update for the subscriber profile data from the profile management system,” as recited in independent claim 13.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that independent claim 13 is anticipated by An.

4. Claims 2–7, 11, and 14–17

At this juncture in the proceeding, AT&T does not address separately Cox’s explanations and supporting evidence regarding challenged claims 2–7, 11, and 14–17. *See generally* Prelim. Resp. 39–45. Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that these claims are anticipated by An.

F. Obviousness Based, in Part, on An

Cox contends that: (1) claim 10 is unpatentable over the combination of An and Bayless; and (2) claims 14, 15, 21, and 22 are unpatentable over the combination of An and Beck. *See* Pet. 40–52. Cox explains how these proffered combinations teach the subject matter of each challenged claim (*id.*), and relies upon the Declaration of Dr. Mir (Ex. 1014) to support its positions. Based on the present record, we are persuaded by Cox’s explanations and supporting evidence. We address the parties’ contentions with respect to each asserted ground in turn.

1. Obviousness Based on the Combination of An and Bayless—Claim 10

Dependent claim 10 recites, in relevant part, “a reporting system generates reports comprising calling parties attempting to connect to the subscriber, indicating each calling party successfully connected to the subscriber and each calling party not successfully connected to the subscriber.” Cox relies upon Bayless as teaching this limitation. Pet. 47–48 (citing Ex. 1009, 60:35–41, 60:52–55, 60:60–63, 61:4–15, Fig. 111). Cox also provides a rationale to combine the teachings of Buhrmann and Bayless.

Id. at 41. In particular, Cox contends that, “[b]ecause An provides a system designed to create and modify a variety of telephone services, a skilled artisan would be readily motivated to incorporate the known telephone call logging feature of Bayless with the known system of An to yield a predictable improvement of available services.” *Id.* (citing Ex. 1014 ¶ 106; MPEP §§ 2143–44) (emphasis omitted).

In response, AT&T contends that Cox does not provide any evidence to support its rationale to combine the teachings of An and Bayless. Prelim. Resp. 52. AT&T asserts that “‘rejections on obviousness cannot be sustained with mere conclusory statements’” *Id.* (quoting *Kahn* 441, F.3d 988). AT&T further argues that both Cox and Dr. Mir simply repeat language from the MPEP to support Cox’s assertion that An and Bayless should be combined, which, according to AT&T, is insufficient to support a conclusion of obviousness. *Id.*

On this record, we are persuaded that Cox’s rationale for combining the teachings of An and Bayless suffices as an articulated reasoning with a rational underpinning that would support the legal conclusion of obviousness. *KSR* supports Cox’s argument and evidence that one of ordinary skill in the art would have incorporated Bayless’s known telephone call logging feature, particularly its ability to log information about each call generated or received by a user, into An’s system. *See* Pet. 41 (citing Ex. 1014 ¶ 106); *KSR*, 550 U.S. at 417.

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that dependent claim 10 would have been obvious over the combination of An and Bayless.

2. *Obviousness Based on the Combination of An and Beck—
Claims 14, 15, 21, and 22*

Dependent claims 14 and 15 recite, in relevant part, “the subscriber profile data is forwarded to the profile management system via at least one intermediate system,” and “the update for the subscriber profile data is received from the profile management system via at least one intermediate system.” Cox relies upon the combination of An and Beck to teach these limitations. Pet. 50 (citing Ex. 1005, 4:16–46, 8:21–25, 8:31–36, Figs. 2, 3, 15, 16; Ex. 1014 ¶ 99; Ex. 1010, 4:27–31, 4:47–48, Figs. 2, 3). Dependent claims 21 and 22 recite, in relevant part, “the intermediate system further comprises SPACE,” and “the profile management system communicates with the client using TCP/IP.” Cox relies upon Beck as teaching these limitations. *Id.* at 51–52 (citing Ex. 1010, 1:55–57, 4:16–18, 4:27–33, 4:53–64, Figs. 2, 3).

Cox also provides a rationale to combine the teachings of An and Beck. Pet. 42. In particular, Cox contends that, “[b]ecause An provides a similar system architecture as Beck, also designed to perform user service management, a skilled artisan would be readily motivated to incorporate the known intermediate SPACE service management system of Beck with the known system of An to yield a predictable improvement.” *Id.* (citing Ex. 1014 ¶ 110; MPEP §§ 2143–44) (emphasis omitted).

In response, AT&T contends that Cox does not provide any objective evidence that supports its rationale to combine the teachings of An and Beck, much less a reason from Dr. Mir to support its conclusion of obviousness. Prelim. Resp. 52. AT&T asserts that, once again, Cox provides a rationale to combine the teachings of An and Beck that is nothing

more than a conclusory statement. *See id.* at 52–53. AT&T also argues that, because An already discloses service manager nodes, modifying An to include Beck’s service management system 250 would be duplicative and not a predictable improvement. *Id.* at 53 (citing Ex. 1005, 3:20–23).

On this record, we are persuaded that Cox’s rationale for combining the teachings of An and Beck suffices as an articulated reasoning with a rational underpinning that would support the legal conclusion of obviousness. *KSR* again supports Cox’s argument and evidence that one of ordinary skill in the art would have incorporated the known intermediate SPACE service management system, as taught by Beck, into An’s system. *See* Pet. 42 (citing Ex. 1014 ¶ 110); *KSR*, 550 U.S. at 417.

To the extent AT&T argues that Beck’s service management system 250 cannot be bodily incorporated into An’s system because An already discloses service manager nodes, we are not persuaded. The test of obviousness is not whether the features of Beck may be bodily incorporated into the system of An, nor is it that the invention embodied in challenged claims 14, 15, 21, and 22 must be suggested expressly in any one or all of these references. Rather, the test is what the combined teachings of Beck and An would have suggested to one of ordinary skill in the art. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Based on the record before us, Cox has demonstrated a reasonable likelihood that it will prevail on its assertion that dependent claims 14, 15, 21, and 22 would have been obvious over the combination of An and Beck.

G. Remaining Grounds

Cox also contends that: (1) claims 1–5, 7, 13–15, 17, and 22 are anticipated under § 102(e) by Blumhardt; (2) claims 8, 9, 18, and 19 are

unpatentable under § 103(a) over the combination of Blumhardt and Boulware; (3) claim 10 is unpatentable under § 103(a) over the combination of Blumhardt, Boulware, and Bayless; (4) claims 14, 15, 21, and 22 are unpatentable under § 103(a) over the combination of Blumhardt and Beck; (5) claims 1–7, 13–17, and 22 are anticipated under § 102(e) by Elliott; (6) claim 10 is unpatentable under § 103(a) over the combination of Elliott and Bayless; and (7) claims 14, 15, 21, and 22 are unpatentable under § 103(a) over the combination of Elliott and Beck. Pet. 20–30, 52–59.

We, however, have broad discretion to institute an *inter partes* review as to some asserted grounds and not others. 37 C.F.R. § 42.108(a) (“the Board may authorize the review to proceed . . . on all or some of the grounds of unpatentability asserted for each claim”); *see also* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances). This discretion is consistent with the requirement that the statutory provisions governing an *inter partes* review proceeding take into account “the efficient administration of the Office,” and “the ability of the Office to timely complete [instituted] proceedings” (35 U.S.C. § 316(b)), as well as the regulatory provision that mandates these proceedings be “construed to secure the just, speedy, and inexpensive resolution of every proceeding” (37 C.F.R. § 42.1(b)). Accordingly, we exercise our discretion and do not institute an *inter partes* review as to the remaining grounds asserted by Cox.

III. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition establishes a reasonable likelihood that Cox will prevail in

challenging claims 1–22 of the '714 patent as unpatentable under §§ 102(e) and 103(a). At this stage of the proceeding, we have not made a final determination with respect to the patentability of these challenged claims.

IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.4, an *inter partes* review is hereby instituted based on the following grounds:

- A. claims 1–7, 12–17, and 20 as being anticipated under § 102(e) by Buhrmann; and
- B. claims 8, 9, 18, and 19 as being unpatentable under § 103(a) over the combination of Buhrmann and Boulware;
- C. claim 10 as being unpatentable under § 103(a) over the combination of Buhrmann, Boulware, and Bayless;
- D. claims 14, 15, 21, and 22 as being unpatentable under § 103(a) over the combination of Buhrmann and Beck;
- E. claims 1–7, 11, and 13–17 as being anticipated under § 102(e) by An;
- F. claim 10 as being unpatentable under § 103(a) over the combination of An and Bayless; and
- G. claims 14, 15, 21, and 22 as being unpatentable under § 103(a) over the combination of An and Beck;

FURTHER ORDERED that no other grounds are authorized for this *inter partes* review other than those identified above; and

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FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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